REMARKS

Applicant acknowledges that the Examiner has withdrawn the 35 U.S.C. § 101 rejection from the October 22, 2003 Office Action.

Status of the Application

Claims 1-39 are all the claims pending in the Application, as claims 34-39 are hereby added. Claims 1-5, 8-16, 19-27 and 30-33 have been rejected.

Allowable Subject Matter

Applicant acknowledges that the Examiner has indicated that claims 6, 7, 17, 18, 28 and 29 would be allowed if rewritten in independent form. However, Applicant declines at this time to draft these claims in independent form since the independent claims should be allowed.

Written Description Rejection

The Examiner has again rejected claims 1, 6, 12, 17, 23 and 28 under 35 U.S.C. § 112, first paragraph, as allegedly not complying with the written description requirement. The Examiner only now has provided a detailed description of the basis of this rejection.

In an effort to speed prosecution, Applicant hereby amends claims 1, 6, 12, 17, 23 and 28 in a clarifying manner to recite "one or more false clauses." Applicant respectfully submits that this amendment does not change the scope of claims 1, 6, 12, 17, 23 and 28, as both "a false clause" and "one or more false clauses" read on embodiments utilizing a singular false clause or multiple false clauses.

Additionally, Applicant maintains that the subject matter of original independent claims 1, 6, 12, 17, 23 and 28 is fully described in *at least* page 10, line 26 through page 11, line 15 of

the instant Application. Specifically, for example, the Application indicates that, "[i]f a SQL statement has two WHERE clauses, then one false WHERE clause is generated and used to replace both of the WHERE clauses." In other words, one false WHERE clause can be used to replace multiple WHERE clauses.

Thus, to maintain the scope of the originally filed claims, claims 34-39 are hereby added, which correspond to claims 1, 6, 12, 17, 23 and 28 as filed.

Obviousness Rejection

The Examiner has rejected claims 1-5, 8-16, 19-27 and 30-33 under 35 U.S.C. § 103(a) as being unpatentable over what the Examiner has alleged to be Applicant's "*Admitted Prior Art*" (hereinafter "*Related Art*") set forth in the "related art" section of the Application (pgs. 1-2).[1] This rejection is respectfully traversed.

Related Art

The *Related Art* indicates: (1) that some database systems, such as DB2 UDB System used on UNIX, Windows NT and OS/2 platforms, supports a DESCRIBE command that lists "column names and data types of a query result" (*i.e.,* metadata); and (2) that other database systems, such as DB2 Version 5 of the OS/390 platform, do not support a DESCRIBE command, instead utilizing modifications to the DML statement to provide metadata. *Specification*, pg. 1, line 20 - pg. 2, line 13.

[1] Applicant has not admitted that the subject matter described in the section of the specification entitled "Description of the Related Art" is prior art that falls within the orbit of 35 U.S.C. § 102.

However, while the *Related Art* indicates that the metadata results obtained by these techniques are useful, there is still "a need in the art of an improved technique of obtaining this information, across platforms." *Specification*, pg. 2, lines 14-15.

The Examiner's Position Regarding Independent Claims 1, 12 and 23

The Examiner takes the following positions (*Office Action*, par. bridging pages 7 and 8):

(1) that the DML (Data Manipulation Language) mentioned in the *Related Art* "is a means to manipulate a database," and is in the form of "SELECT <attribute list>, FROM <table list>, WHERE <condition>;"

(2) that "<condition> is a Boolean (TRUE, FALSE) expression that identifies the tuples to be retrieved by the query;" and

(3) "[i]n order to alter the DML statement to return no data, or no tuples to be retrieved by the query, obviously, the select statement must be executed with the WHERE clause modified to be FALSE."

Thus, the Examiner alleges that the *Related Art* discloses that the DML "technique as discussed performs the claimed 'modifying the query to replace one or more selected clauses with a false clause; executing the modified query with the false clause'" (*Office Action*, pg. 8, lines 3-4).

The Examiner Has Still Not Established Prima Facie Obviousness

As an initial matter, the Examiner has not applied any particular reference that reasonably supports any of the allegations (1) - (3) above.

Specifically, the only applied reference is the *Related Art*, which merely indicates that "a developer can alter the Data Manipulation Language (DML) statement so that it returns no data, but allows access to the metadata." Even assuming that the *Related Art* qualifies as prior art under 35 U.S.C. § 102, it is respectfully submitted that this bare disclosure cannot support any of the above allegations, as there is simply no teaching or suggestion of any: (1) SELECT / FROM / WHERE format; (2) Boolean expressions; or (3) FALSE clauses.

Regarding the Examiner's allegations (1) and (2), these seem to be drawn from specific pages of a reference entitled *Fundamentals of Database Systems*, which was included with the instant Office Action. Applicant notes that this reference has not been applied in the current Action. Thus, the Examiner's detailed reliance on it to support the entire reasoning of his rejection herein is improper. If the Examiner wishes to utilize the detailed description of *Fundamentals of Database Systems*, he should issue a new Non-Final Office Action.[2]

Regarding the Examiner's allegation (3) that the select statement is executed with the WHERE clause modified to be FALSE, Applicant respectfully submits that this allegation is incorrect and unsupported.

Specifically, there is simply no mention of the use of any "false clause," or the replacement of a selected clause by a "false clause," in the *Related Art* (or, for that matter, *Fundamentals of Database Systems*). Thus, not all of the claim limitations are taught or

[2] Further, it is not even clear that *Fundamentals of Database Systems* is prior art to the instant Application, as the Examiner has not indicated a precise publication date.

suggested, and *prima facie* obviousness cannot be established. *In re Royka*, 490 F.2d 981 (CCPA 1974).

In fact, the Examiner has specifically conceded, in the previous Office Action (*see* pg. 4, par. #8), that there is no teaching or suggestion of any use of such a "false clause" in the the *Related Art.*

The only indication of the claimed use of a "false clause" as a replacement for a selected clause is provided by the description of this invention in the instant Application. However, the Examiner is simply not permitted to use this description of the Applicant's invention to provide a motivation to modify the DML of the *Related Art*, as the use thereof is impermissible hindsight. *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

The Examiner seeks to rebut Applicant's indication that this rejection is based upon impermissible hindsight by citing *In re McLaughlin*'s provision that "so long as [the rejection] takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper."

However, this is precisely the problem with the Examiner's rejection. In no prior art reference anywhere has the Examiner cited the use of a "false clause." Only the instant Application indicates the use of such a "false clause." Thus, the Examiner cannot reasonably argue that he has not used "knowledge gleaned only from Applicant's disclosure" to support his rejection.

Thus, Applicant respectfully submits that independent claims 1, 12 and 23 are patentable over the *Related Art*. Further, Applicant respectfully submits that rejected dependent claims 2-5, 8-11, 13-16, 19-22, 24-27 and 30-33 are allowable, *at least* by virtue of their dependency.

Thus, Applicants respectfully request that the Examiner withdraw this rejection.

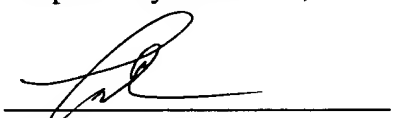
Conclusion

In view of the foregoing, it is respectfully submitted that claims 1-39 are allowable. Thus, it is respectfully submitted that the application now is in condition for allowance with all of the claims 1-39.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please charge any fees which may be required to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,



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